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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,856	10/12/2005	Ronald W. McGhee	16-946	2510
26294 7590 03/17/2010 TAROLLI, SUNDHEIM, COVELL & TUMMINO L.L.P. 1300 EAST NINTH STREET, SUITE 1700 CLEVEVLAND, OH 44114				
EXAMINER				
SELF, SHELLEY M				
ART UNIT		PAPER NUMBER		
3725				
MAIL DATE		DELIVERY MODE		
03/17/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/552,856

Applicant(s)

MCGHEE ET AL.

Examiner

Shelley Self

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 21-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 21-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 16, 2010 has been entered.

Response to Amendment

The amendment filed on February 16, 2010 has been considered but is ineffective to place the application in condition for allowance. Further, Examiner notes the amendment is improper. For example the amendment includes amended claims having underlined (i.e. added limitations) deleted portions; however the amendment filed February 16, 2010 does not carry through the correct underlined and deleted/relined portions from the last entered amendments. Examiner notes the after-final amendment filed December 14, 2009 was NOT entered, therefore limitations set forth in that amendment (12/14/09) have not been entered and any changed/amended structure must be carried through and properly indicated with either underlining or deletions from the most previous entered amendment, i.e. the amendment filed July 20, 2009.

Terminal Disclaimer

An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c). Examiner notes the attorney that has signed the Terminal Disclaimer does not have Power of Attorney (POA), i.e. there has been no POA filed in this case. Therefore the Terminal Disclaimer is not approved.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-15 and claims 21-25 as noted in the previous Office Action (4/23/09) and claims 26-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/552873.

Although the conflicting claims are not identical, they are not patentably distinct from each other because there are merely reworded and encompass similar subject matter/scope.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-15 as noted in the previous Office Action (4/23/09) and claims 21-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 7,490,641. Although the conflicting claims are not identical, they are not patentably distinct from each other because as noted above regarding co-pending Application 10/552873, the claims of the presently presented application are merely reworded and broader than that of the patented case, '641. Accordingly the narrower claims of the patent '641 serve to anticipate the broadly presented claims of the current application.

Specification

The amendment filed February 16, 2010 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: *An infeed system...to a processing machine...a workpiece feed path operatively coupled to the processing machine.*

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-15 and 21-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As noted in the previous Office Action (10/14/09), neither the originally filed disclosure nor the drawings provide support for a processing machine (clms. 1, 24, 26).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 and 21-31 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claims 1-15 and 21-25, as noted in the previous Office Action (10/14/09) regarding claims 1, 24 and 16, neither the originally filed disclosure nor the drawings provide support for a processing machine. The original disclosure supports structure including a planer, planer-matcher or moulder. The recitation of a processing machine encompasses embodiments and scope not fully supported by the original disclosure. Accordingly Applicant is required to cancel the new matter in the reply to this Office Action.

With regard to claim 26 it is unclear how the step of "determine a desired gap between the first and second workpieces..." is carried out. Examiner notes this is a functional recitation that lacks any positively recited structure necessary to carry out the function.

With regard to claims 26 and 27, it is unclear how an optimized cutting solution is determined when there is no structure positively recited to cut the workpiece.

With regard to claim 28 there is no antecedent basis for the recitation, "said one or more attributes". What is meant by "said one or more attributes" and how does this mechanically interrelate and cooperate with the rest of the positively recited limitations? Clarification is required.

With regard to claim 30 there is no positive recitation of any movement of the cutting device, therefore the recitation, "*minimum time required for repositioning a component of the cutting device*" is not understood. Clarification is required.

Additionally regarding claim 30 there is insufficient antecedent basis for the recitation, "the cutting device"; is this a reference to the cutting apparatus of claim 29? Clarification is required.

With regard to claim 31, there is insufficient antecedent basis for the recitation, "said optimized cutting solution". Appropriate correction is required.

Examiner notes the above listing of 35 U.S.C. 112 rejections is not conclusive and Applicant is required to review all of the claims for clarity, definiteness, positive recitation of mechanical cooperation between elements and proper antecedent basis to facilitate a clear understanding of the claimed invention.

Response to Arguments

Applicant's arguments filed February 16, 2010 have been fully considered but they are not persuasive. Applicant argues that the Specification and 35 U.S.C. 112 1st paragraph

rejections are not proper because the specification supports the use of a processing machine. To support this argument, Applicant references page 33 lines 9-16 and figures 29-32 of the specification. This argument is not deemed persuasive, because as noted in the previous Office Action, an optimizing planer is a processing machine, as is a planer-matcher and moulder (all clearly supported in the original disclosure), however there are other processing machines such as a joiner, planer-joiner, jointer, planer-sander, router/drilling machines or board edger. There is nothing in the originally filed disclosure to support the use of all or other processing machines such as a joiner, planer-joiner, jointer, planer-sander, router/drilling machine, board edger. The recitation of a processing machine changes the scope from that of a planer to any processing machine. Furthermore, Applicant's reference to the specification page 33, lines 9-16 and figures 29-32 does not clearly support any processing machine and in fact clearly states, "an optimizing planer". The original disclosure is absent support for the use of any processing machine and not only fails to enable and support the use of all processing machines but clearly illustrates and defines specific processing machines to include as noted above, a planer, planer-matcher or moulder. Accordingly Applicant's remarks are not deemed persuasive and the rejection stands.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is 571-272-4524. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on 571-272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shelley Self/
Primary Examiner, Art Unit 3725

SS
March 15, 2010